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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,400	12/28/2001	Shinji Yamasoto	7388/72545	1864

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/019,400

Applicant(s)

YAMASOTO ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 20 February 2004 and 23 February 2004, have been entered. Claims 1-5 are pending in the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitations "the high-density polyethylene layer" in line 4 and "the metal foil layer" in line 6. There is insufficient antecedent basis for these limitations

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in the claim. To prosecute the examination of claim 3 on its merits, the examiner assumes claim 3 to depend from claim 2.

***Claim Rejections - 35 USC § 103***

4. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuichi (JP 04-189779 A) in view of Caggiano (US 4,861,632).

Regarding claim 1, Yuichi discloses a patch package (Figures 1 and 2) with a first sheet (11) having a first moisture-permeable layer (14) of unspecified moisture permeability rate, a first screen material layer (12) for blocking penetration of moisture and light, and a first hygroscopic material layer (13) comprising a first resin containing an unspecified wt% of inorganic filler (see USPTO translation 2003-3872, page 5, lines 13-16). Yuichi discloses forming a bag by using a single sheet folded such that the moisture-permeable layer (14) is oriented on the inner portion of the bag and heat-sealing the edges (see USPTO translation 2003-3872, page 6, lines 15-19).

Yuichi lacks or does not expressly disclose the use of two sheets to form the bag, a moisture permeability rate of 40-120 g/m<sup>2</sup>/day, and a 20-40 wt% of organic filler.

As to the wt% of organic filler, Yuichi discloses the general conditions claimed by the applicant. Yuichi suggests modification of material to effect performance of the water-absorbing layer (see USPTO translation 2003-3872, page 6, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the organic filler in the ranges claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have reasonably expected success since the materials all perform as expected.

As to the moisture-permeability rate, Yuichi discloses the general conditions claimed by the applicant. Yuichi suggests modification of thickness and material to adjust the water absorbing speed (see USPTO translation 2003-3872, page 6, lines 8-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the moisture permeability layer of Yuichi in the ranges claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have reasonably expected success since the materials all perform as expected.

As to the use of two sheets to form the bag, Caggiano discloses that a moisture-absorbing bag (Figure 4) formed from two sheets and sealed at their edges was an equivalent structure known in the art at the time the invention was made. Therefore, because these two bag forming methods were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the two sheet method of Caggiano for the single sheet method of Yuichi. One of ordinary skill in the art would have reasonably expected success since the bag would perform equally well with either forming method.

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Regarding claim 4, Yuichi discloses forming a bag by heat-sealing the edges (see USPTO translation 2003-3872, page 6, lines 15-19). Yuichi-Caggiano as applied to claim 1 above, discloses the claimed invention except for the specific heat seal strengths. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the package of Yuichi-Caggiano with the claimed heat seal strengths, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuichi-Caggiano as applied to claim 1 above, and further in view of Wilking (US 5,698,217).

Regarding claim 2, Wilking discloses that it was known in the art at the time the invention was made to use low density polyethylene (LDPE) or high density polyethylene (HDPE) with a foil laminate in a patch package having moisture absorbing properties (see for example, Wilking Col. 4, lines 47-54). Yuichi discloses a first resin as belonging to the olefin group (in which polyethylene is included). Yuichi suggests modification of the material to effect performance (see for example, USPTO translation 2003-3872, page 6, lines 8-10). Yuichi-Caggiano as applied to claim 1 above, discloses the claimed invention except for the first and second resin of LDPE and the screen layer being an HDPE-foil laminate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Yuichi-Caggiano with a

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first and second resin of LDPE and the screen layer of an HDPE-foil laminate, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 3, the patch package of Yuichi-Caggiano-Wilking, as applied to claim 2 above, discloses the general conditions claimed by the applicant. The base reference Yuichi is on the same scale claimed by the applicant (see USPTO translation 2003-3872, page 5, lines 7-11). Yuichi suggests modification of the thickness to effect performance (see for example, USPTO translation 2003-3872, page 4, lines 10-12, page 6, lines 8-10). As to the specific thickness ranges, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukahara et al (H-7-28550 supplied by applicant) in view of Yuichi-Caggiano-Wilking as applied to claims 1-4 above.

Tsukahara et al discloses a patch package (Figure 3). Tsukahara et al discloses a patch and support (A) with a pressure-sensitive adhesive composed of styrene-isoprene-styrene blocked copolymer (see translation of paragraph [0020]). Tsukahara et al discloses an interior total surface area in the range claimed by the applicant (see Figure 3 as compared to Figure 1 of the instant application). Tsukahara et al lacks or does not expressly disclose a bag with moisture absorbing capabilities.

The patch package of Yuichi-Caggiano-Wilking as applied to claims 1-4 above, discloses the claimed patch package. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the patch and support of Tsukahara et al in a package as taught by Yuichi-Caggiano-Wilking in order to provide an adjustable speed bag to absorb the water from the package (see for example, USPTO translation 2003-3872, page 3, lines 15-20).

### ***Response to Arguments***

7. Applicant's arguments filed 20 February 2004 have been fully considered but they are not persuasive.

8. In response to applicant's argument that there is no suggestion to modify the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all motivation can be found in the prior art of record.

9. In response to the applicant's arguments on the silence of the quantitative relationships, when the reference is a utility patent, it does not matter that the feature



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shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). See MPEP § 2125

10. In response to the applicant's arguments based on *In re Tomlinson*, the applicants have not shown unexpected results. All materials are disclosed or suggested in the prior art and the optimization of the thickness and materials is suggested in Yuichi.

11. In response to applicant's arguments based on *In re Antonie*, Yuichi suggests which parameters to vary. Further, applicant has not shown that the results of the claimed materials and thickness were unexpectedly good. Yuichi discloses which parameters to vary to obtain the result of variation of moisture-absorbing speed.

12. The arguments spanning pages 9 and 10 amount to a showing that the claimed package meets the requirements of its intended use. However, the applicant fails to show unexpected results. The teachings of Yuichi-Caggiano-Wilking-Tsukahara et al suggest the claimed structure.

13. An examiner's affidavit is not necessary since the examiner has not presented information that is not disclosed or suggested in the prior art. This argument was answered in the previous Office action.

14. Applicant's arguments with respect to claims 2 and 3 have been considered but are moot in view of the new ground(s) of rejection.

15. In response to the applicant's arguments on the heat-seal strength, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

16. In response to the applicant's arguments concerning claim 5, Tsukahara et al discloses a patch and support (A) with a pressure-sensitive adhesive composed of the claimed styrene-isoprene-styrene blocked copolymer. As to the interior surface area, Tsukahara et al discloses an interior total surface area in the range claimed by the applicant (see Figure 3 as compared to Figure 1 of the instant application). When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). See MPEP § 2125.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory Pickett  
Examiner  
31 March 2004

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700

Partial translation of H7-28550:

[0019]

There is no limitation in the use of the types of the adhesives. For example, any types including an acryl base, a rubber base, a silicone base and the like can be used. In particular, the acryl base and the rubber base are preferably used.

[0020]

As for the acrylic adhesive, a variant that contains a (metha)acrylic acid alkyl ester copolymer as a main component is preferably applied. As for the rubber adhesive, the following components are preferably contained as main components: a styrene-isoprene-styrene block copolymer; styrene-butadiene rubber; polybutane; polyisoprene; butyl rubber; and natural rubber and the like.

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3/31/04  
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